

**REMARKS/ARGUMENTS*****Status of Claims***

Claims 1-6 were previously canceled.

Claim 7 was previously amended.

Claims 8-10 are currently amended.

Claims 11-15 were previously canceled.

Applicant hereby requests further examination and reconsideration of the presently claimed application.

***Specification***

The title of the invention stands objected to in that it is not indicative of the invention to which the claims are directed. Applicant respectfully requests that the title of the invention be changed to "Provision of Directed Sales Incentives at Locations Apart From the Point of Sale."

***Request for Reconsideration and Withdrawal of Finality of Office Action***

Applicant respectfully requests that the Examiner reconsider and withdraw the finality of the office action mailed August 24, 2006. In the response to office action dated November 15, 2005, Applicant amended independent claim 7, and its dependent claims 8-10, to recite subject matter that is not disclosed by *Bair* (WO 99/23585). More specifically, claim 7 was amended to recite the limitation of storing consumer information and product information independent of promotion information, determining the intersection of the consumer information, the product information, and the promotion information, and storing the intersection in the database, which is supported by paragraphs 25-39 of the specification. *Bair* fails to disclose any type of promotion, or the manipulation of any type of promotion information. Consequently, *Bair* fails to anticipate amended claim 7. In conducting the initial prior art search, the Examiner is presumed to have

considered the invention as claimed. Under such circumstances, MPEP 706.07(a) clearly states that a final rejection is improper:

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.

In the present case, the subject matter added by amendment should reasonably have been expected to be claimed. Thus, the Examiner's decision to perform additional searching and rely on completely new art that was not previously of record, namely *Deaton* (US 5,649,114), was not necessitated by Applicant's amendment. Applicant merely amended the original independent claim to include limitations not contained in *Bair*. Therefore, Applicant respectfully requests reconsideration and withdraw of the finality of the office action as expressly required by MPEP 706.07(a). In the event that the Examiner elects to maintain the finality of the office action, Applicant respectfully requests supervisory review of such decision.

#### ***Claim Rejections – 35 USC § 102***

Claims 7-10 stand rejected under § 102(b) as anticipated by *Deaton* (U.S. Patent No. 5,649,114). According to MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Claim 7 recites subject matter that is not disclosed by *Deaton*.

The Office Action explains that *Deaton* teaches “determining the intersection of the promotion information, the purchase information, and the customer information and storing the intersection in a database as a “customer incentive report.” Office Action at 3 (citing *Deaton* Col. 90, lines 36-50 and Fig 35). However, reading *Deaton* Col. 90, lines 36-50 in context with the remainder of its specification reveals, not a teaching of the formulation of a “customer incentive

report,” but rather, methods of providing point of sale (“POS”) coupons. *See Deaton* Col. 9, lines 17-30 (“FIGS. 30 and 31 are the program flow diagrams illustrating the method of building a coupon list for a *POS disbursement of coupons* . . . FIG. 32 is a program flow diagram of a subroutine for coupon disbursements, providing the perform build coupon list in the flow diagram of FIG. 30 . . . FIG. 35 is a program flow diagram of a subroutine for the echo coupon procedure shown in FIG. 32.) (emphasis added).

The “customer incentive report” claimed in the instant Application is quite different from POS coupons. First, the “customer incentive report” is not provided to the customer at the POS, but rather before the customer begins the shopping experience to serve as a guide to the promotional items available to that specific customer during that specific shopping experience. *See Application* at 7, lines 18-26 (“Then, whenever the customer goes shopping, her or she may go to one of the kiosks before beginning shopping and presents the card 22 to the customer interface 28. The store level computer 12 includes means for accessing information about the special offers available to the customer associated with the card, and generates a customized list of special offers to the offer communicator 32. The customer then has a shopping list of special offers to use while shopping. The customer does not engage in any selection process, but instead is quickly processed by the kiosk.”). Second, while *Deaton* speaks to reduction of costs associated with marketing by implementing the use of targeted marketing at the POS, *see Deaton* Col. 61, lines 42-45, *Deaton’s* teachings do not eliminate the costs associated with operating in a coupon-based environment (i.e., the cost of printing coupons and the cost of mailing coupons not provided at the POS). *See Deaton* Col. 7, lines 33-37. The instant Application’s “customer incentive report” does not require printing a multitude of coupons at the point of sale or the subsequent mailing of those coupons to potential customers. *Compare* Office Action at 4 (“As to claim 10, Deaton teaches wherein the

delivery step comprises delivery of a printed copy of the third table to the corresponding user (see col. 118, lines 28-35, Fig. 17A and B, Deaton.”) *with Deaton* Fig. 17A and B (“(5) CUSTOMER TENDERS PURCHASE WITH A PERSONAL CHECK OR PROVIDES A PHONE # . . . (14) POINT OF SALE COUPONS OF VARYING VALUE ARE AVAILABLE FOR CUSTOMER . . . (40) COUPONS DISPENSED EITHER IN MANUAL PACKETS OR WITH COUPON PRINTER”). Furthermore, the “customer incentive report” eliminates the need for customers to “select, clip, and carry coupons” altogether. *See* Application at 10, line 8. As is evident from the above discussion, *Deaton’s* teachings with respect to the instant Application are limited to actions at the point of sale. Therefore, *Deaton* does not anticipate the instant Application’s non-point of sale provision of the “customer incentive report.” Furthermore, claims 8-10 have been amended to clearly denote that (i) not only are they dependant on claim 7, but (ii) they are specifically directed to the non-point of sale “customer incentive report.” Therefore, because *Deaton* does not anticipate claim 7, i.e., the non-point of sale provision of claim 7, claims 8-10 are also allowable.

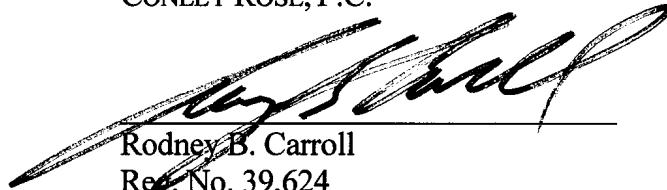
## CONCLUSION

Consideration of the foregoing remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicant. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated August 24, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.



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